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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,713	05/05/2006	Oliver Meyer	03869.105778	5156
86528	7590	02/22/2010	EXAMINER	
King & Spalding LLP 401 Congress Avenue Suite 3200 Austin, TX 78701			COPPOLA, JACOB C	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/595,713

**Applicant(s)**

MEYER ET AL.

**Examiner**

JACOB C. COPPOLA

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 46-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-67 is/are rejected.
- 7) ☒ Claim(s) 46-67 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/88)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 05 May 2006 and 26 June 2007.

## **DETAILED ACTION**

### ***Acknowledgements***

1. This action is in reply to the amendments to the claims and remarks filed on 25 November 2009 ("09 Nov Response").
2. Claims 46-67 are currently pending and have been examined.
3. This Office Action is given Paper No. 20100209. This Paper No. is for reference purposes only.
4. Based on a comparison of Pre-Grant Publication No. U.S. 2007/0038571 A1 ("PGPub") with Applicants' originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicants' specification. Therefore, if necessary, any references in this Office Action (or in any future Office Action) to Applicants' original specification will refer to paragraph numbers in the PGPub (e.g., ¶ 0043).

### ***Restrictions***

5. The restriction requirement of the previous Office Action, mailed on 26 October 2009, is hereby withdrawn.

### ***Information Disclosure Statement***

6. The Information Disclosure Statements filed 05 May 2006 and 26 June 2007 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

***Drawings***

7. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicants are required to furnish a drawing under 37 C.F.R. §1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 C.F.R. §1.121(d).

***Claim Rejections - 35 USC §101***

8. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 46-67 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

**Regarding Claims 46 and 67**

10. Claims 46 and 67 recite computer programs only. "Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed." MPEP §2106.01 I. Because the claims recite only abstractions that are neither "things" nor "acts," the claims are not within one of the four

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statutory classes of invention<sup>1</sup>. Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

11. Additionally, Applicants' original specification expressly describes the claimed communication entity (MUA) as an "MMS user application MUA." See PGPub, at least ¶ 0041. Moreover, Applicants' original specification expressly describes the claimed management entity (DA) as a "DRM agent DA." See PGPub, at least ¶ 0041. Finally, Applicants' original specification expressly describes the claimed switching component (VK) (claim 67 only) as an "MMS switching unit." See PGPub, at least ¶ 0011. Because the claimed "communication entity," "management entity," and "switching component" may be interpreted as software only (see definitions of application, agent, and unit below), the claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

12. Additionally, the Examiner notes that using the broadest reasonable interpretation of "interface," as noted below, the claimed interface is interpreted as software only. Because the broadest reasonable interpretation of "interface" includes software only, the claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

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<sup>1</sup> 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures, and composition of matter. The latter three categories define "things" (or products) while the first category defines "actions" (*i.e.*, inventions that consist of a series of steps or acts to be performed).

***Claim Rejections - 35 USC §112, Second Paragraph***

13. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 46-67 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

**Regarding Claims 46 and 67**

15. Claim 46 recites “encrypted useful data objects” and “useable useful data object.” Claim 46 is indefinite because “useful” and “useable,” within the context of this claim, is subjective. In other words, one of ordinary skill in the art would not understand how to distinguish whether a particular data object is “useful” (or “useable”) or not.

16. Claim 46 recites “a time information... which is received in the context of the receipt of the at least one encrypted useful data object...” Claim 46 is indefinite because the meaning of the “received *in the context of* the receipt of the... object” (emphasis added) is unclear. One of ordinary skill in the art would not be able to determine what constitutes being “received in the context of the receipt of the... object.” Additionally, claim 46 only recites “a communication entity *for* receiving at least one... object” (emphasis added). Accordingly, claim 46 is indefinite because the “the receipt of the... object” (and “the receipt of a useable useful data object”) lacks antecedent basis in the claim.

17. Claim 46 recites “a communication entity for receiving at least one encrypted useful data object” and “the receipt of a useable useful data object.” Claim 46 is indefinite because it is unclear whether the “useable useful data object” is one of the encrypted useful data objects or not.

18. Claim 46 recites “specifies the time-point by when *a rights object* assigned to the at least one encrypted useful data object will arrive...” (emphasis added) and “to output a signal... concerning the receipt of a useable useful data object... only if the management entity (DA) receives *a rights object* before the specified time-point” (emphasis added). Claim 46 is indefinite because it is unclear whether the “a rights object” (to be received by the management entity) is referring to the “a rights object assigned to the at least one encrypted useful data object.”

19. Claim 67 recites the same limitations as discussed above, and therefore is rejected for the same reasons as above.

20. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, second paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

***Allowable Subject Matter***

21. Claims 46-67 would be allowable if rewritten or amended to overcome the objection to the claims and the rejections under 35 U.S.C. §§ 112, 2nd paragraph, and 101 set forth in this Office action.

***Claim Interpretation***

22. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision. See MPEP §2111.01 IV.

23. The Examiner finds that because the examined claims recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because the examined claims fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that all examined claims (*i.e.* claims 46-67) do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

24. In light of Applicants’ choice to pursue product claims, Applicants are reminded that functional recitations using the word and/or phrases “to,” “for,” “adapted to,” or other functional language (*e.g.* claim 46 recites “a communication entity (MUA) for receiving...”) have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product



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from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all claims currently pending.

25. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.<sup>2</sup> Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

*agent* “1. A program that performs a background task for a user and reports to the user when the task is done or some expected event has taken place.” Computer Dictionary, 5<sup>th</sup> Edition, Microsoft Press, Redmond, WA, 2002;

*application* “A program designed to assist in the performance of a specific task, such as word processing, accounting, or inventory management.” *Id.*;

*interface* “2. Software that enables a program to work with the user (the user interface, which can be a command-line interface, menu-driven interface, or a graphical

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user interface), with another program such as the operating system, or with the computer's hardware." *Id.*;

*unit* "(3) A software component that is not subdivided into other components." IEEE Standard Computer Dictionary, The Institute of Electrical and Electronics Engineers, New York, NY, 1990.

### *Conclusion*

26. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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<sup>2</sup> While most definitions are cited because these terms are found in the claims, the Examiner has provided additional definitions to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

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have questions on access to the Private PAIR system, please contact the Electronic

Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/

Patent Examiner, Art Unit 3621

February 9, 2010

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621